

**REMARKS**

Claims 1-10 have been examined. With this amendment, Applicant adds claims 11-14.

Claims 1-14 are all the claims pending in the application.

**1. Claim Rejections Under § 102**

The Examiner has rejected claims 1-3 and 5-10 under 35 U.S.C. § 102(e) as being anticipated by Safai et al. (US 6,167,469) [“Safai”]. For at least the following reasons, Applicant traverses the rejection, first with respect to independent claim 1, as now amended.

Claim 1 recites an image data processing system comprising a digital camera and an instruction means “wherein said communication section for said digital camera transmits and receives image data based on said instructions from said instructions means.” The Examiner contends that modems 214, 604 and PSTN 606 of Safai correspond to the claimed communication apparatus.

Safai does not disclose or even remotely suggest that the communication section for the digital camera receive image data as set forth in amended claim 1. At most, Safai discloses that a user can send one or more stored images from the camera to an external address (col. 7, lines 35-37). Therefore, Applicant submits that Safai does not anticipate at least this element in claim 1. Applicant therefore respectfully requests the Examiner to withdraw this rejection of claim 1.

Claims 5 recites a digital camera comprising an instruction means wherein “the connecting section is capable of receiving image data based on said instructions from said instructions means.” Because this feature is similar to that recited in claim 1, Applicant submits that claim 5 is patentable for at least the reason given above with respect to claim 1.

Claim 6 recites a processing device comprising an output means “wherein said output means outputs said image data to said digital camera in accordance with instructions from said digital camera.” Because this feature is similar to that recited in claim 1, Applicant submits that claim 6 is patentable for at least the reason given above with respect to claim 1.

Applicant submits that dependent claims 2, 3 and 7-10 are patentable at least by virtue of their respective dependencies.

## **2. Claim Rejection Under § 103**

The Examiner has rejected claim 4 under 35 U.S.C. § 103 (a) as being unpatentable over Safai in view of Fukuoka (US 5,754,227) [“Fukuoka”]. For at least the following reasons, Applicant traverses the rejection.

Because Fukuoka does not disclose receiving image data based on instructions from a digital camera, it does not cure the deficient teachings of Safai. Even taken together, for what they would have meant as a whole to an artisan of ordinary skill, the combined teachings of these two references does not lead the artisan of ordinary skill to such a feature. Therefore, Applicant submits that claim 4 is patentable at least by virtue of its dependency from independent claim 1, as now amended.

In addition, the Examiner concedes that Safai does not disclose the claimed plurality of second processing means but applies Fukuoka to allegedly cure the deficiency.

Applicant submits that the Examiner’s proffered reason for combining is not supported in the prior art. “The mere fact that references can be combined or modified does not render the

resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP at 2100-131.

Here, Fukuoka provides no suggestion for the desirability of providing a plurality of printers. The Examiner’s reasoning is, at best, mere speculation and does not provide the objective reason to combine as required by the MPEP. Therefore, Applicant submits that the Examiner’s speculation does not provide evidence in the record as required by *Zurko*. See *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

### **3. New Claims**

With this amendment Applicant adds claims 11-14. Applicant submits that these claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

### **4. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Pursuant to 37 C.F.R. § 1.136, Applicant is hereby submitting a petition (with fee) for one month of extension time, making this response due on or before October 7, 2004. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the

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Respectfully submitted,

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**23373**

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